

## REMARKS

In the Final Office Action mailed December 5, 2008, claims 1, 4, 11-38, 59-62, 81-82, 87 and 89-93 were pending and stand finally rejected. Further consideration of the present application including claims 1, 4, 11-38, 59-62, 81-82, 87 and 89-93 is respectfully requested.

Claims 36-38 stand rejected under 35 USC §102(b) as anticipated by U.S. Patent No. 5,423,826 to Coates et al. In maintaining the rejection based on Coates, the examiner asserts that Fig. 19 in Coates “clearly discloses guide member 180 mounted to the stationary member and spaced proximally from the plate (Fig. 19).” Claim 36 recites that the guide member is “mounted to said stationary member proximally of said holding system with said guide member spaced proximally from said plate when said holding system is engaged to said plate along said longitudinal axis and with said at least one guide member positioned relative to said plate to guide placement of a bone engaging fastener through said at least one hole.” (Emphasis added.) In Fig. 19, guide member 180 is not mounted to any stationary member. Therefore, even if guide member 180 in Fig. 19 is spaced proximally from the plate as asserted by the examiner, there is no disclosure that in this position guide member 180 is mounted to any structure at all. When guide member 180 is mounted to the instrument, Coates discloses that guide member 180 is positioned in foot 157. There is no disclosure that guide member 180 is both mounted to any portion of either of members 151, 152 of instrument 150 and spaced proximally of foot 157. Therefore, claim 36 along with its dependent claims 37-38 are not disclosed in Coates et al.

Claims 1, 4, 11-14, 18, 20-27, 81-82, 87, 92 and 93 stand rejected under 35 USC §103(a) as being unpatentable in view of U.S. Patent App. Pub. No. 2003/0105462 to Haider alone. In the Response to Arguments portion of the Final Office Action, the examiner asserts that the “Examiner has clearly explained how Haider renders Applicant’s claimed invention obvious. Haider clearly discloses an opening with an hour-glass shape. The opening inherently has a maximum and minimum width, although a specific numeric value has not been provided for the maximum width or the minimum width. Applicant’s claimed invention is merely changing the dimensions of various portions of an opening having an hour-glass shape. Therefore, it is the Examiner’s position that the rejections under 35 USC 103(a) are proper.” It is respectfully submitted that Applicant’s are not merely changing the dimensions of the opening having an

hourglass shape. Applicants are claiming a relationship between the opening and the structural members of the plate extending along the opening that is neither disclosed nor taught in Haider or any of the other cited references. The examiner appears to mistakenly consider that claim 1 is reciting a maximum width of the opening. However, claim 1 makes no reference to any maximum width of the opening. The plain language of claim 1, as supported by the specification, indicates that the maximum width in claim 1 is directed to the first and second members of the plate that extend alongside the opening. The opening itself is recited to include a minimum width, and it is this minimum width that is greater than the combined maximum widths of the structural members of the plate that extend alongside the opening. This organization and relationship between the claimed elements is not disclosed or taught in Haider, and withdrawal of this basis of the rejection of claim 1 is respectfully requested along with claims 4, 11-14, and 18 depending from claim 1.

Claim 20 recites, among other features, “wherein said intermediate portion includes a first member along one side of said visualization opening and a second member along the opposite side of said visualization opening, said first and second members each including an outer side surface defining an outer most side of said plate and an inner side surface opposite said outer side surface, said inner side surfaces defining respective opposite sides of said visualization opening that extend along said longitudinal axis, wherein said first and second members each include a maximum width transversely to said longitudinal axis between said inner side and said outer side surface thereof, said visualization opening including a minimum width transversely to said longitudinal axis between said opposite sides thereof, said minimum width of said visualization opening being greater than said maximum widths of said first and second members combined.” (Emphasis added). As discussed above with respect to claim 1, Haider fails to disclose or suggest at least these features in claim 20, and the Office Action does not establish a prima facie case for rejecting claim 20 based on Haider. Therefore, withdrawal of this basis of the rejection of claim 20 is respectfully requested along with claims 21-22 and 92-93 depending from claim 20.

Haider also fails to disclose or suggest the features in claim 81. For example, the members along the central element in Haider do not include a uniform width along the central element. Rather, the members have a variable width due the different curvatures of the inner and outer sides

of the walls along the central element. Fig. 2 of Haider shows the sidewall along the central element has a curvature that is different than the curvature of the outer sidewall so that the width of the members along the central element is not uniform. Haider provides no discussion or further teaching about the members along the central element. Fig. 3 in Applicant's disclosure, as described in the specification, shows the sidewall along the opening and the adjacent outer sidewall of the plate along opening correspond to one another so that the widths of the members along the opening are uniform. It is not clear why Fig. 2 of Haider would teach the elements arranged in the manner recited in claim 81 when Haider discloses members along the central element of the plate that have non-uniform widths, and is completely silent as to any teaching, suggestion, or reason, for modifying the members of Haider so that "said inner and outer surfaces of said first member and said inner and outer surfaces of said second member each define a width along said longitudinal axis that is uniform along a length of said visualization opening" as recited in claim 81.

Claim 87 depending from claim 81 is allowable as discussed above with respect to claim 1 since Haider also does not disclose or teach that the minimum width of the central element is greater than the combined maximum widths of the members along the central element. Withdrawal of this basis of the rejection of claims 82 and 87 depending from claim 81 is respectfully requested.

Claims 1, 4, 11-15, 18-27, 81-82, 87, 92 and 93 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,413,259 to Lyons et al. alone. The examiner recognizes that Lyons et al. fail to disclose and hour-glass shape of the visualization opening, the curvatures of the sidewalls of the visualization opening, and the widths and the length-to-width ratios of the visualization opening. The examiner points to page 12, lines 22-23 of applicant's specification and asserts that the disclosure of possible other shapes for openings 60 for other embodiments means "that there is no criticality to providing an hour-glass shape to the visualization opening" and the claimed features "are rendered obvious when a person of ordinary skill in the art changes the size and/or shape of visualization opening 28." The examiner further asserts that "Applicant's use of claim terminology such as 'first and second members' only obfuscates what is actually being claimed, namely, dimensions of various portions of a visualization opening."

It is respectfully submitted that this rejection also appears to be based again on the incorrect premise that the claims merely recite dimensions of the visualization opening. As

discussed above, Applicant's are not merely claiming the dimensions of the opening. Applicant's claim a relationship between the opening and the members of the plate extending along the opening that is neither disclosed nor taught in Lyons or any of the other cited references. The examiner appears to mistakenly consider that somehow the claim is reciting a maximum width of the opening. However, the maximum width in claim 1 is directed to the first and second members of the plate that extend alongside the opening, and are not directed to any maximum dimension of the opening. The opening itself is recited to include a minimum width, and it is this minimum width that is greater than the combined maximum widths of the members that extend alongside the opening. This organization and relationship between the claimed elements is not disclosed or taught in Lyons, nor has the examiner been able to point to any such teachings in the prior art, and withdrawal of this basis of the rejection of claim 1 is respectfully requested along with claims 4, 11-15, 18 and 19 depending from claim 1.

Lyons et al. also fail to disclose or suggest the features in claim 20. For example, as discussed above with respect to claim 1, there is no disclosure or teaching in Lyons et al. or any other cited reference that the minimum width of hole 28 is greater than the combined maximum widths of the members that extend along hole 28. Therefore, withdrawal of this basis of the rejection of claim 20 is respectfully requested along with claims 21-27 and 92-93 depending from claim 20.

Lyons et al. also fail to disclose or suggest the features in claim 81. For example, the members along hole 28 in Lyons et al. do not include a uniform width along hole 28. The members have a variable width due the different curvatures of the inner and outer surfaces of the members along hole 28. Therefore, withdrawal of the rejection of claim 81 based on Lyons et al. is respectfully requested. Also, as discussed above, Lyons et al. also do not disclose or teach that the minimum width of hole 28 is greater than the combined maximum widths of the members along the hole 28 and therefore do not teach claim 87. Withdrawal of this basis of the rejection of claim 87 along with claim 82 depending from claim 81 is respectfully requested.

Claims 16-17, 28-35 and 89-91 stand rejected as being unpatentable over Lyons et al. in view of U.S. Patent No. 6,193,721 to Michelson. Claims 16 and 17 depend from claim 1 and are allowable at least for the reasons claim 1 is allowable over Lyons et al. as discussed above.

Claim 28 recites, among other features, a plate and a holding instrument that includes a holding system engaged to the plate by clamping end walls of the plate, and “wherein said first and second holding members move toward and away from one another in a direction that follows said longitudinal axis of said plate and further comprising a pair of guide members on said holding instrument positioned on opposite sides of said longitudinal axis when said holding system is engaged to said plate.” The examiner does not identify any disclosure or teaching of the claimed pair of guide members positioned on opposite sides of the longitudinal axis of the plate when the holding instrument is engaged to the plate in a direction that follows the longitudinal axis of the plate as recited in claim 28. In Michelson, the examiner asserts that compression post 54 is a guide member. However, Michelson discloses that compression posts 54 are received in bores 106, 132 in arms 104, 130. The rejection fails to consider that compression posts 54 cannot be offset on opposite sides of the longitudinal axis when received in the bores of arms 104, 130 that are located along the longitudinal axis. Therefore, a prima facie case for rejecting claim 28 has not been established and withdrawal of the rejection of claim 28 is respectfully requested.

Claims 29-35 depend from claim 28 and are also allowable at least for the reasons claim 28 is, and at least claims 32 and 34 are independently allowable for the reasons provided in applicant’s previous response, neither of which were addressed or responded to in the Final Office Action. Therefore, withdrawal of the rejection of claims 29-35 depending from claim 28 is also requested.

With respect to claim 89, the examiner has not identified any portion of the cited references that teach or suggest a plate and holding instrument combination where the holding instrument also includes at least one guide member mounted to a stationary member of an actuating system with the guide member positioned relative to the longitudinal axis of the plate “in offset relation to said longitudinal axis so that said at least one guide member is positioned relative to said plate to guide placement of a bone engaging fastener through said at least one hole when said first and second holding members are engaged to said plate along said longitudinal axis.” The examiner identifies elements 54 in Michelson as guide members, but as discussed above with respect to claim 28, compression posts 54 are not arranged in offset relation to the longitudinal axis of the plate when compression posts 54 are received in the bores of the arms 104, 130 when arms 104, 130 are

engaged to the plate along its longitudinal axis. Therefore, withdrawal of the rejection of claim 89 is respectfully requested along with claims 90 and 91 depending therefrom.

Claims 1, 4, 11-15, 18, 20-27, 92 and 93 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,954,722 to Bono et al. alone. The examiner admits that, like Lyons et al. discussed above, Bono et al. fail to disclose a visualization opening having an hourglass shape, concave/convex curvatures of the visualization opening walls, and the claimed widths and the length-to-width ratios. However, in maintaining the rejection the examiner asserts that the “claimed features are rendered obvious when a person of ordinary skill in the art changes the size and/or shape of visualization opening 59.” Furthermore, despite applicant’s previous request for clarification, the examiner maintains and reiterates that Bono discloses a visualization opening 59. A review of Bono et al. did not reveal any opening or any other element labeled with reference numeral 59.

The examiner does not provide any reasoning as to why one of ordinary skill in the art would modify Bono in a manner to arrive at the claimed invention, nor has the examiner cited any prior art reference that teaches these features. The examiner does not provide any reasoning why a change in the size and/or shape of the opening in Bono necessarily results in the claimed invention.

The maximum width in claim 1 is directed to the first and second members of the plate that extend alongside the opening, and are not directed to any dimension of the opening. The opening itself is recited to include a minimum width, and it is this minimum width that is greater than the combined maximum widths of the members that extend alongside the opening. This organization and relationship between the claimed elements is not disclosed or taught in Bono, nor has the examiner been able to point to any such teachings in the prior art, and withdrawal of this basis of the rejection of claim 1 is respectfully requested along with claims 4, 11-15, and 18 depending from claim 1.

Bono et al. also fail to disclose or suggest the features in claim 20. For example, as discussed above with respect to claim 1, there is no disclosure or teaching that the minimum width of graft hole 25 is greater than the combined maximum width of the members that extend along graft hole 25. Therefore, withdrawal of this basis of the rejection of claim 20 is respectfully requested along with claims 21-27 and 92-93 depending from claim 20.

Claims 59-62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bono et al. in view of Boucher et al. and, separately, over Lyons et al. in view of Boucher et al. Claim 59 recites, among other features, “wherein said first and second members each include a maximum width transversely to said longitudinal axis between said inner side and said outer side surface thereof, said visualization opening including a minimum width transversely to said longitudinal axis between said opposite sides thereof, said minimum width of said visualization opening being greater than said maximum widths of said first and second members combined.”

With respect to claim 59, as discussed above, it is respectfully submitted that Bono et al. and Lyons et al. fail to disclose or suggest that the minimum width of either graft hole 25 or circular hole 28 thereof, respectively, is greater than the combined maximum width of the members that extend along graft hole 25 or hole 28 in the manner recited in claim 59. Boucher et al. fail to remedy these deficiencies in Bono et al and Lyons et al. Therefore, claim 59 is allowable along with claims 60-62 depending therefrom.

In addition, the examiner appears to be relying on personal knowledge in order to make modifications to Haider, Lyons et al. and Bono et al. to arrive at the claimed invention. For example, the examiner asserts that the invention is rendered obvious when one of ordinary skill in the art changes the size and/or shape of the visualization openings of these references, but the examiner has not provided any reason why one of ordinary skill in the art would modify the references to arrive at the claimed invention when there appear to be an unlimited number of ways the size and/or shapes of the openings could be changed that still would not result in the claimed invention. It is respectfully submitted that the examiner’s statement that the “claimed features are rendered obvious when a person of ordinary skill in the art changes the size and/or shape of the opening” and similar statements made in rejecting claims 1, 20, and 59 is not a proper reference -- being neither a public document that can be authenticated (such as a patent or other publication) nor an affidavit/declaration of personal knowledge per MPEP §2144.03. If the examiner’s knowledge or the asserted teaching is derived from applicant’s disclosure, then the rejection is not proper since applicant’s specification is not a reference upon which the examiner may properly rely to support a rejection.

In view of the foregoing, the present application including claims 1, 4, 11-38, 59-62, 81-82, 87 and 89-93 is in condition for allowance. The examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By: 

Douglas A. Collier

Reg. No. 43,556

Krieg DeVault LLP

One Indiana Square, Suite 2800

Indianapolis, Indiana 46204-2079

(317) 238-6333 voice

Doc.1948523